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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/029,508 | 10/19/2001 | Dan Kikinis | ISURFTV148 | 4578 |

52940 7590 03/28/2006

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| EXAMINER |
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BUI, KIEU OANH T

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| ART UNIT | PAPER NUMBER |
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2623

DATE MAILED: 03/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/029,508 | Applicant(s) KIKINIS, DAN | |
| | Examiner KIEU-OANH T. BUI | Art Unit 2611 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>01/31/2002</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections – 35 USC 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless --
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.*

2. Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Picco et al. (U.S. Patent No. 6,029,045).

Regarding claim 1, Picco discloses a same method as a first set of (television) channels based on a predetermined criteria related to a viewer's preference, and also inserting into the first set of channels a first channel not selected (by the viewer) based on the predetermined criteria related to the viewer's preference (refer to col. 3/line 43 to col. 4/line 12 for local content can be added to the viewer's channel at some predetermined time based on the predetermined criteria of the viewer's preference; and col. 6/lines 17-41 for advertisements are inserted into a broadcasting channel which is not selected by the viewer, yet the content is related to the viewer's preference based on the predetermined criteria).

As for claim 2, Picco teaches this feature as the system operator inserts the content into a first channel of the first set of channels (col. 5/lines 19-54).

Art Unit: 2611

As for claim 3, Picco teaches this feature as the system disallows the insertion when some content does not match the criteria related to the viewing preference (Fig. 9, at steps 234 & 236, col. 13/lines 42-52).

As for claim 4, Picco further teaches this feature as the time expiration for the displaying content on the channel can be predetermined (col. 6/line 62 to col. 7/line 6).

As for claim 5, Picco further teaches this feature as the viewer statistics can be collected and used for targeting appropriate local contents based on the viewer's geographic location (col. 6/line 62 to col. 7/line 32 for users' data or profile is collected within a local area).

As for claim 6, Picco teaches this feature as the channel is selected based on a predetermined subject matter (col. 6/lines 17-41 for an example of "automobiles" as a predetermined subject matter of automobile is presented).

Regarding claims 7, Picco discloses: "A machine-readable medium that provides instructions that, when executed by a machine, cause the machine to operations" (Fig. 7/item 120 -Set top box, which has CPU 188 for execute the program), comprising:

a first set of (television) channels based on a predetermined criteria related to a viewer's preference, and also inserting into the first set of channels a first channel not selected (by the viewer) based on the predetermined criteria related to the viewer's preference (refer to col. 3/line 43 to col. 4/line 12 for local content can be added to the viewer's channel at some predetermined time based on the predetermined criteria of the viewer's preference; and col. 6/lines 17-41 for advertisements are inserted into a broadcasting channel which is not selected by the viewer, yet the content is related to the viewer's preference based on the predetermined criteria).

As for claim 8 and 14, Picco teaches this feature as the system operator inserts the content into a first channel of the first set of channels (col. 5/lines 19-54).

Regarding claim 9 and 15, Picco further disclose this feature as the system disallows the insertion when some content does not match the criteria related to the viewing preference (Fig. 9, at steps 234 & 236, col. 13/lines 42-52).

As for claim 10 and 16, Picco further teaches this feature as the time expiration for the displaying content on the channel can be predetermined (col. 6/line 62 to col. 7/line 6).

As for claim 11 and 17, Picco further teaches this feature as the viewer statistics can be collected and used for targeting appropriate local contents based on the viewer's geographic location (col. 6/line 62 to col. 7/line 32 for users' data or profile is collected within a local area).

As for claim 12 and 18, Picco teaches this feature as the channel is selected based on a predetermined subject matter (col. 6/lines 17-41 for an example of "automobiles" as a predetermined subject matter of automobile is presented).

Regarding claim 13, Picco discloses a system comprising: a first unit to providing a first set of channels, the first set of channels selected based on a predetermined criteria related to a viewing preference of a viewer, and a second unit coupled with the unit to insert into the first set of channels a first channel not selected based on the predetermined criteria related to the viewing preference of the viewer (col.3/line 14-37).

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Newberry et al and Srinivasan (PTO-892 attached) disclose systems related to provide channel related to the viewer's preference based on the predetermined criteria.

4. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to PTO New Central Fax number:

(571) 273-8300, (for Technology Center 2600 only)

*Hand deliveries must be made to Customer Service Window,
Randolph Building, 401 Dulany Street, Alexandria, VA 22314.*

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krista Kieu-Oanh Bui whose telephone number is (571) 272-7291. The examiner can normally be reached on Monday-Friday from 9:30 AM to 7:00 PM, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, John Miller can be reached on (571) 272-7353.

Art Unit: 2611

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'K. Bui', with a long horizontal flourish extending to the right.

Kieu-Oanh Bui
Primary Examiner
Art Unit 2611

KB

Mar. 17, 2006